

REMARKS

Claims 1, 13, 25, 32-34, 37 and 44-46 have been canceled, and Claims 2, 8, 10-11, 14, 20, 22-23, 26, 35, 38 and 47 have been amended. Claims 2-12, 14-24, 26-31, 35-36, 38-43 and 47-48 are pending in the application. In view of the remarks that follow, reconsideration is respectfully requested.

Allowable Claims

Noted with appreciation is the indication on page 4 of the Office Action that Claims 2-7, 9, 11-12, 14-19, 21, 23-24, 26-31, 35-36, 38-43 and 47-48 each recite allowable subject matter, and would be allowed if rewritten in independent form.

Accordingly, the limitations of Claim 1 have been added to Claim 2, the limitations of Claim 13 have been added to Claim 14, the limitations of Claim 25 have been added to Claim 26, and the limitations of Claim 37 have been added to Claim 38. Thus, allowable Claims 2, 14, 26 and 38 have each been converted into independent form. These modifications do not change the scope of any of these claims. Claims 2, 14, 26 and 38 thus are thus now in proper condition for allowance, and notice to that effect is respectfully requested.

The dependency of allowable Claim 11 has been changed so that Claim 11 now depends from allowable Claim 2, the dependency of allowable Claim 23 has been changed so that Claim 23 now depends from allowable Claim 14, the dependency of allowable Claim 35 has been changed so that Claim 35 now depends from allowable Claim 26, and the dependency of allowable Claim 47 has been changed so that Claim 47 now depends from allowable Claim 38. The scope of Claims 2, 14, 26 and 38 is such that these dependency changes do not cause any modification to the effective scope of Claims 11, 23, 35 and 47. Claims 11, 23, 35 and 47 are thus now believed to be in proper condition for allowance, without any need to separately place them in independent form.

Allowable Claims 3-7, 12, 15-19, 24, 27-31, 36, 39-43 and 48 each depend directly or indirectly from one of allowable Claims 2, 14, 26 and 38. Claims 3-7, 12, 15-19, 24, 27-31, 36,

39-43 and 48 are thus all believed to now be in proper condition for allowance, without any need to separately place them in independent form.

Allowable Claims 9 and 21 respectively depend from Claims 8 and 20. Claims 8 and 20 were rejected on the merits, but are believed to be allowable for reasons discussed below. Accordingly, it is believed to be unnecessary to separately place allowable Claims 9 and 21 in independent form at this time.

Amendments to the Drawings

The Office Action objected to the drawings, indicating that the label "Prior Art" should be added in each of Figures 1, 2a, 2b and 3. The foregoing amendments implement these required drawing changes. Applicants are enclosing replacement drawing sheets that include these required changes. It is respectfully submitted that the drawings are now in proper form, and notice to that effect is respectfully requested.

Claim 8

The foregoing amendments add to Claim 8 the limitations of Claim 1, in order to convert Claim 8 from dependent form into independent form. These modifications do change the scope of Claim 8.

The Office Action rejected Claim 8 under 35 U.S.C. §102, on the ground that it is completely anticipated by what the Office Action refers to as "Applicants' admitted prior art" (Figures 1, 2a, 2b and 3 of the present application, and the "Background" section on pages 2-3 of the present application). This ground of rejection is respectfully traversed, for the following reasons.

The PTO specifies in MPEP §2131 that, in order for a reference to anticipate a claim under §102, the reference must teach each and every element recited in the claim. Applicants' Claim 8 recites that:

... the access point calculates the scheduling parameter for each of the forward communication links and access terminals as a function of one or more weighting factors, a maximum data transmission rate, and an average data transmission rate for the corresponding forward communication link and access terminal.

The Office Action asserts that the admitted prior art includes a teaching of the use of at least one weighting factor to calculate a scheduling parameter (in the text running from line 24 on page 2 of the Office Action through line 4 on page 3). However, Applicants have carefully reviewed the indicated portion of their application, and respectfully submit that it does not teach the use of any weighting factor. In particular, it discusses calculation of a scheduling parameter based on a peak data transmission rate and an average data transmission rate, but does not mention that the calculation is based on any other factor, much less a weighting factor. Therefore, since the indicated portion of the present application does not teach each and every element recited in Claim 8, the requirements discussed in MPEP §2131 are not met, and Claim 8 is not anticipated under §102 by the indicated portion of the present application. Claim 8 is therefore believed to be allowable, and notice to that effect is respectfully requested.

Claim 20

The foregoing amendments add the limitations of Claim 13 to Claim 20, in order to convert Claim 20 from dependent form into independent form. These modifications do not change the scope of Claim 20.

Claim has been rejected under §102, for the same reason as Claim 8. The rejection of Claim 20 is respectfully traversed. Claim 20 recites that:

... the access point is adapted to calculate the scheduling parameter for each of the forward communication links and access

terminals as a function of one or more weighting factors, a maximum data transmission rate, and an average data transmission rate for the corresponding forward communication link and access terminal.

Accordingly, for the same basic reasons discussed above with respect to Claim 8, it is respectfully submitted that the requirements discussed in MPEP §2131 are not met, and that Claim 20 is therefore not anticipated under §102 by the indicated portion of the present application. Accordingly, Claim 20 is believed to be allowable, and notice to that effect is respectfully requested.

Claim 10

The foregoing amendments add to Claim 10 the limitations of Claim 1, in order to convert Claim 10 from dependent form into independent form. These modifications do not change the scope of Claim 10.

Claim 10 stands rejected under 35 U.S.C. §103, on the ground that this claim would be obvious in view of what the Office Action refers to as "Applicants' admitted prior art" (Figures 1, 2a, 2b and 3 of the present application, and the "Background" section on pages 2-3 of the present application). This ground of rejection is respectfully traversed. In this regard, the PTO recognizes in MPEP §2142 that:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

Applicants respectfully submit that the Office Action fails to establish a prima facie case of obviousness under §103 with respect to Claim 10, for the following reasons.

THE PRIOR ART MUST TEACH ALL CLAIM LIMITATIONS UNDER §103

The MPEP repeatedly emphasizes the requirement that, in order to establish obviousness under §103, "the prior art reference (or references when combined) must teach or suggest all the claim limitations" (emphasis added). The PTO considers this requirement to be important, as evidenced by the fact that this exact language appears at a number of different locations in the MPEP, for example in each of MPEP §706.02(j), MPEP §2142, and MPEP §2143. In the present application, Claim 10 recites that:

. . . the access point calculates the scheduling parameter for each of the forward communication links and access terminals as a function of a priority of the data to be sent to the corresponding access terminal.

The §103 rejection of Claim 10 is based solely on teachings drawn from selected figures and the background section of the present application, which the Office Action refers to as "Applicants' admitted prior art". The Office Action admits at lines 17-18 on page 3 that "The admitted prior art fails to disclose priority of data to be sent to access terminal". Thus, the Office Action admits that the admitted prior art does not disclose all of the limitations of Claim 10. Consequently, the admitted prior art does not meet the requirement for a §103 rejection that is set forth in several different sections of the Office Action. Therefore, for this independent reason alone, it is respectfully submitted that the Office Action fails to meet a requirement needed to establish a prima facie case of obviousness under §103, and that Claim 10 is not obvious under §103 in view of the teachings drawn from the present application. Notice to that effect is respectfully requested.

THE PROPOSED MODIFICATION TO THE "ADMITTED PRIOR ART" IS IMPROPER

Even assuming that the foregoing argument does not apply (which is clearly not the case), there is yet another independent and compelling reason why the proposed modification of "Applicants' admitted prior art" is not proper under §103. In this regard, MPEP §2142 provides that:

To reach a proper determination under §103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. . . . Knowledge of applicant's disclosure must be put aside in reaching this determination, . . . impermissible hindsight must be avoided, and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

In addition, the MPEP provides at § 2143.01 that:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. . . . Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so". (Emphasis in original).

As discussed above, the present Office Action admits at lines 17-18 on page 3 that "The admitted prior art fails to disclose priority of data to be sent to access terminal". The Office Action therefore goes on to assert that:

. . . to use priority in the transmission system is well known in the art. Therefore, it would have been obvious to use priority to make the system more efficient since high priority data can be transmitted prior than the low priority data.

In effect, what the Office Action is asserting is that the proposed modification of the admitted prior art to meet Claim 10 would have been well within the ordinary skill of the art. Stated differently, the Office Action is effectively relying on the level of skill in the art to provide the suggestion to modify Applicants' admitted prior art. However, this approach is directly prohibited by the provisions of MPEP §2143.01, which state that:

FACT THAT THE CLAIMED INVENTION IS WITHIN THE
CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART
IS NOT SUFFICIENT BY ITSELF TO ESTABLISH *PRIMA*
FACIE OBVIOUSNESS

A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. [Case citations

omitted] . . . (The level of skill in the art cannot be relied upon to provide the suggestion to combine references).

Here, the prior art relied on does not teach all the aspects of the claimed invention. The Examiner is relying on the level of skill in the art not only for one of the elements of the claimed invention (which is improper), but also for the motivation to modify Applicants' admitted prior art (which is also improper). The approach taken in the Office Action is an approach that is directly prohibited by the provisions of MPEP §2143.01. As noted above, the explanation of the §103 rejection essentially asserts that the proposed modification of Applicants' admitted prior art to meet Claim 10 would have been within the capabilities of a person skilled in the art. However, as emphasized in MPEP §2143.01, this is not permissible, because the level of skill in the art cannot be relied upon to provide the suggestion for modifying teachings of the prior art. The present §103 rejection of Claim 10 is therefore incomplete, because it fails to demonstrate the motivation that is required by the MPEP. In effect, the §103 rejection is based on hindsight of the present invention, rather than on motivation properly derived from what was known prior to the present invention. Accordingly, for this independent reason alone, it is respectfully submitted that the Office Action fails to establish all of the requirements for a prima facie case of obviousness under §103, and that Claim 10 is therefore not rendered obvious under §103 by Applicants' admitted prior art. Notice to that effect is respectfully requested.

In view of the various different reasons discussed above, it is respectfully submitted that Claim 10 is not rendered obvious under §103 by Applicants' admitted prior art. Claim 10 is therefore believed to be allowable, and notice to that effect is respectfully requested.

Claim 22

The foregoing amendments add the limitations of Claim 13 to Claim 22, in order to convert Claim 22 from dependent form into independent form. These modifications do not change the scope of Claim 22.

Claim 22 has been rejected under §103, for the same reason as Claim 10. However, the rejection of Claim 22 is respectfully traversed. Claim 22 recites that:

... the access point is adapted to calculate the scheduling parameter for each of the forward communication links and access terminals as a function of a priority of the data to be sent to the corresponding access terminal.

For the same basic reasons discussed above with respect to Claim 10, it is respectfully submitted that the requirements discussed in MPEP §§ 706.02(j), 2142, 2143 and 2143.01 are not met, and that Claim 22 is therefore not obvious under §103 in view of Applicants' admitted prior art. Accordingly, Claim 22 is believed to be allowable, and notice to that effect is respectfully requested.

Conclusion

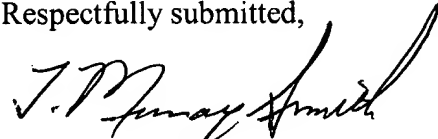
Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way

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by a telephone conference, the Examiner is invited to telephone the undersigned attorney at
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Respectfully submitted,



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Enclosure: Replacement Drawing Sheets 1-3
Amendment Transmittal
Check (\$800.00)
Acknowledgement Postcard

R-100147.1

Amendments To The Drawings

Three attached drawing sheets include Figures 1, 2a, 2b and 3, and replace the three original sheets that included Figures 1, 2a, 2b and 3. In the replacement sheets, Figures 1, 2a, 2b and 3 have each been amended to add the label "Prior Art", as required by the Examiner.

Attachment: Replacement Sheets 1-3